

REMARKS

In the Office Action mailed October 9, 2007, the Examiner provisionally rejects claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatenable over claims 1 of US Patent Application Serial No. 10/752,761. The Examiner objects to the title of the invention as non-descriptive and objects to the specification, figures 1a, 1b, 1c, 5c, 6a and 8d, as well as claims 26 through 30 and 33, on the basis of informalities. The Examiner rejects claims 1, 2, 4, 8 through 12, 14, 18 through 22, 24 and 28 through 30 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,757,707 to Houghton, et al. ("Houghton"). Claims 3, 7, 13, 17, 23 and 27 are rejected under 35 U.S.C. § 103(a) as obvious over Houghton in view of US Patent Publication No. 2004/0091236 A1 to Boston, et al. ("Boston"). Claims 5, 15, 16, 25 and 26 are rejected under 35 U.S.C. § 103(a) as obvious over Houghton in view of Boston and in further view of U.S. Patent No. 6,813,639 to Nobakht, et al. ("Nobakht").

Claims 1 through 30 are currently pending in the present application, with claims 1, 11 and 21 being independent claims. By way of the present Response, Applicants hereby amend claims 1, 11 and 21, as well as cancel claims 10, 20 and 30. No new matter has been added and the amendments are supported by the specification as originally filed. For at least the reasons set forth below, Applicants respectfully submit that all pending claims are allowable and respectfully request withdrawal of the rejection of claims 1 through 9, 11 through 19 and 21 through 29.

The Examiner rejects pending claim 1 under the judicially created doctrine of double patenting over claim 1 of US Patent Application Serial No. 10/752,761. Applicants note that this is a provisional rejection as US Patent Application Serial No. 10/752,761 is still pending. In order to advance the prosecution of the present application, however, Applicants

submits herewith a timely filed Terminal Disclaimer in compliance with 37 C.F.R. 1.321(c) to obviate the provisional rejection.

The Examiner objects to the title of the invention as non-descriptive. The Examiner further objects to the specification at page 9, line 7; page 17, line 4; page 19, lines 9, 14 and 18; page 25, lines 8 and 23; and page 26, lines 1 and 9 based upon informalities. Applicants amend the title of the invention, as well as the specification, in accordance with the Examiner-noted informalities. In view thereof, withdrawal of the objections is respectfully requested.

Figures 1a, 1b, 1c, 5c, 6a and 8d are objected to on the basis of a number of informalities. Accordingly, the Examiner requires new corrected drawings in compliance with 37 CFR 1.1.21(d). In response, Applicants submit replacement figures 1a, 1b, 1c, 5c, 6a and 8d. In view thereof, withdrawal of the objection is respectfully requested.

The Examiner rejects claims 1, 2, 4, 8 through 12, 14, 18 through 22, 24 and 28 through 30 under 35 U.S.C. § 102(e) as being anticipated by Houghton. Independent claim 1, as currently amended, is directed to a system comprising a user computer, coupled to a data network, to display a user interface usable to enter a plurality of user preferences. The system further comprises a server coupled to the data network to receive said plurality of user preferences from said user computer and to generate non-broadcast content based on said plurality of user preferences. A broadcast-based client-side device, coupled to the network, is to receive broadcast programming content from a broadcast source and said non-broadcast content from said server and is to display said non-broadcast content and said broadcast programming content on a display of said broadcast-based client-side device. The non-broadcast content is displayed in accordance with said plurality of user preferences and includes overlay data to display one or more overlays on said

display in conjunction with said broadcast programming content, said one or more overlays selected by a user from a list of overlays. Independent claims 11 and 21 are directed to a method and a computer system, respectively, which comprise substantially similar elements to those comprising independent claim 1.

Houghton discusses a web-based TV system that incorporates a computer-implemented method of displaying related sources of viewing content and includes receiving a user input specifying a URL address corresponding to a web page, determining a corresponding television channel and displaying the corresponding television channel. (Houghton, Col. 3, Lines 40-46). Houghton fails to teach or suggest all of the claim elements of independent claim 1, as currently amended. Specifically, Houghton fails to teach or suggest the claim element “wherein said non-broadcast content is displayed in accordance with said plurality of user preferences and includes overlay data to display one or more overlays on said display in conjunction with said broadcast programming content, said one or more overlays selected by a user from a list of overlays.” Although the Examiner points to Houghton’s discussion of simultaneously displaying content from two or more content sources in rejecting claim 10, which by way of the present amendment has now been incorporated into currently amended claim 1, Houghton fails to teach or suggest the display of overlays selected by a user from a list of overlays. At best, Houghton discusses the simultaneous display of overlays without the interaction of a user selecting the overlay to be displayed from a list of different overlays.

Applicants have conducted a thorough review of Houghton respectfully assert that Houghton, considered alone or in combination with the prior art of record, does not teach or suggest at least a “broadcast-based client-side device to display said non-broadcast content and said broadcast programming content on a display of said broadcast-based client-side device, and wherein

said non-broadcast content is displayed in accordance with said plurality of user preferences and includes overlay data to display one or more overlays on said display in conjunction with said broadcast programming content, said one or more overlays selected by a user from a list of overlays.” Accordingly, Applicants respectfully request withdrawal of the rejection of independent claims 1, 11 and 21 and allowance of the same.


The dependent claims of the present application contain additional features that further substantially distinguish the invention of the present application over Houghton, Hassell and the prior art of record. Given the Applicants’ position on the patentability of the independent claims, however, it is not deemed necessary at this point to delineate such distinctions.

For at least all of the above reasons, Applicants respectfully request that the Examiner withdraw all rejections, and allowance of all the pending claims is respectfully solicited. To expedite prosecution of this application to allowance, the Examiner is invited to call the Applicants’ undersigned representative to discuss any issues relating to this application.

Dated: January 7, 2008

THIS CORRESPONDENCE IS BEING
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Respectfully submitted,



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